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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,092	01/04/2005	Peter Josef Martin	2004-280	7017
27569	7590	07/25/2008		
PAUL AND PAUL 2000 MARKET STREET SUITE 2900 PHILADELPHIA, PA 19103			EXAMINER WEEKS, GLORIA R	
			ART UNIT 3721	PAPER NUMBER
			NOTIFICATION DATE 07/25/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/520,092

Applicant(s)

MARTIN, PETER JOSEF

Examiner

GLORIA R. WEEKS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment and remarks received on April 29, 2008.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19, 20, 22-26, 28-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Niske (USPN 4,746,058).

In reference to claim 19, 20, 22, 24-26, 28-30, Niske discloses a packaging material that is folded into a packaging and subsequently filled (column 1 lines 5-14 and 61-65), the packaging material comprising: longitudinal and transverse 12 fold lines; and stamped straight line markings 11, 14, 14', 14" separate from the fold lines, and having intersecting paths that correlate to dimensions of the packaging, the markings 11, 14, 14', 14" comprising a parallelogram (32 x1) within a first rectangular frame (32 x2) that has sides that are parallel to the longitudinal fold lines, and the first rectangular frame within a second rectangular frame (32 x3), such that a corner of the parallelogram (32 x1) bisects¹ a side of the second rectangular frame (32 x3); wherein the markings 11, 14, 14', 14" have a "U-shaped" cross-section. Page 5, lines 26-37 of Applicant's specification defines the phrase "U-shaped cross-section" as a configuration that projects into our out of a respective surface. Column 5 lines 21-27 of Niske disclose the markings 11, 14, 14', 14" as indentations, thereby meeting Applicant's limitation of

markings having a “U-shaped cross-section. As shown below, the stamped markings project² from an upper and lower side of the wall panel defined by the fold lines.

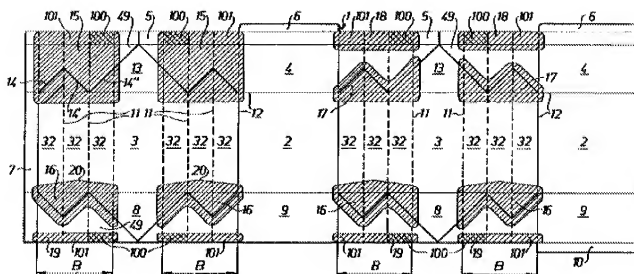


Figure 1 of Niske

Illustration of fold lines disclosed by Niske

¹ To divide into two parts (The American Heritage dictionary)

² To extend out (American Heritage Dictionary)

Regarding claim 23, column 4 lines 17-29 and column 5 lines 45-55 of Niske disclose an association of the markings 14, 14', 14'' with the dimensions and geometry of the package.

With respect to claims 31-34, Niske discloses a process of producing a package, comprising: applying longitudinal and transverse 12 fold lines to a packaging material; stamping³ straight line markings 11, 14, 14', 14'' having intersecting paths, the markings 11, 14, 14', 14'' comprising a parallelogram (32 x1) within a first rectangular frame (32 x2) that has sides that are parallel to the longitudinal fold lines, and the first rectangular frame within a second rectangular frame (32 x3), such that a corner of the parallelogram (32 x1) bisects⁴ a side of the second rectangular frame (32 x3); wherein the markings 11, 14, 14', 14'' have a "U-shaped" cross-section. Page 5, lines 26-37 of Applicant's specification defines the phrase "U-shaped cross-section" as a configuration that projects into or out of a respective surface; reading the markings 11, 14, 14', 14'' with an optical sensor (column 6 lines 60-68); and shaping the packaging material into a container; and filling and sealing the packaging material (column 4 lines 35-53).

4. Claims 19, 23-25, 29 and 30 are rejected 35 U.S.C. 102(b) as being anticipated by Johnson (USPN 3,956,872).

In reference to claims 19, 23-25, 29 and 30, Johnson discloses a packaging comprising: a blank having longitudinal and transverse fold lines; and a stamped marking on a wall panel (R) of the packaging blank, the marking comprising at least one center-symmetrical configuration having two straight lines having intersecting paths (dates including letters such as E, H, M, etc. and symbols – or /); wherein the marking correlates to dimensions and the geometry of the

³ to crush or grind with a heavy instrument (The American Heritage Dictionary)

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packaging as the markings are applied to a specific region of the packaging. Since the marking is recessed into the wall panel of the packaging, it is understood that a cross-section of the marking will have be U-shaped and have substantially a uniform thickness.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niske (USPN 4,746,058).

In reference to claims 21 and 27, Niske discloses a packaging material having stamped straight line markings 14, 14', 14'' that are read for the purpose of determining proper alignment of the blank during a folding, sealing and filing operation, wherein the markings include a pair of intersecting angled lines 14, 14 or 14', 14'' (column 5 lines 45-55; column 6 lines 56-68). Niske does not disclose the angled markings to define a rhombus. On page 5 of Applicant's specification, the angled sides of the rhombus marking are disclosed to permit detection of the angular alignment of the packaging material. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the a packaging material with markings defining a rhombus shape or a pair of intersecting angled markings since the Examiner takes Official Notice of the equivalence of a single pair of intersecting angled markings and markings

⁴ To divide into two parts (The American Heritage dictionary)

that define a rhombus for their use in the packaging art, and the selection of any of these known equivalents to determine proper alignment of packaging material would be within the level of ordinary skill in the art.

Response to Arguments

7. Applicant's arguments filed April 29, 2008 have been fully considered but they are not persuasive, but are not found persuasive.
 8. During patent examination of the claims, the pending claims must be given their broadest reasonable interpretation consistent with the specification.⁵ Moreover, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, *this is not the mode of claim interpretation to be applied during examination*. During examination, the claims must be interpreted as broadly as their terms reasonably allow.⁶ Regarding the interpretation of the term "separate", with respect to the relationship between the fold lines and markings of the claimed packaging, Examiner has defined the term as existing as an independent entity and distinct.⁷
- With respect to the rejection of Applicant's invention over Niske, Applicant has argued that Niske fails to disclose a packaging having fold lines that are separate from markings, rather Applicant has found Niske to only disclose fold lines. While the markings, as interpreted by Examiner, are indentations that permit folding of the packaging, the marking are separate and distinct from the fold lines as cited by Examiner. The structural limitations required by Applicant to define a marking are met by elements 11, 14, 14', 14" of Niske, since elements 11,

⁵ *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). See also MPEP § 2111.

⁶ *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). See also MPEP § 2111.01.

⁷ American Heritage Dictionary

14, 14', 14'' are stamped, separate from the fold line elements 12, and are capable of being read or detected by a scanner. A reference is not limited to what the patentees describe as their own invention(s) or to the problem(s) with which they are concerned; rather the reference is relevant for all it contains. Essentially, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. The fact that the markings 11, 14, 14', 14'' of Niske permit additional functions, such as permitting a surface of the packaging to fold, does not negate the fact that the claimed limitations are indeed met.

Applicant also argues that the markings 11, 14, 14', 14'' do not assist with controlling processing of the packaging. Applicant states that the markings permit a sensor to determine angular orientation, as well as the dimensions of the packaging, thereby ensuring that processing of the packaging occurs as desired. As discussed above, Examiner has found the markings of Niske to meet the structural limitations of Applicant's markings as claimed, thus the markings of Niske would permit the same processing advantages. As illustrated by Niske, the markings are transverse to the fold lines, such that a sensor is capable of measuring the angular relationship of the fold lines with respect to the markings to determine the alignment and size of the packaging. Such a relationship provides the "reference value" Applicant argues is necessary to meet the limitation of controlling the packaging process.

9. In response to Examiner's rejection of Applicant's invention over Johnson, Applicant has argued that Johnson fails to disclose the claimed markings, since Applicant has found the markings of Johnson to not offer the advantages of Applicant's invention. Applicant appears to agree that the markings of Johnson meet the structural limitation of Applicant's claimed

invention, as the markings of Johnson are stamped at on designated portions of the packaging; however, Applicant disputes Johnson's teaching of markings that offer the same information as the claimed markings. Again, the markings of the cited prior art, in this case Johnson, meet the structural limitations of Applicant's markings as claimed, thus the markings of Johnson would permit the same processing advantages.

10. Applicant's final argument was drawn to Examiner's interpreted equivalency of Applicant's claimed marking of a rhombus shape, and Niske disclosure of a marking of a triangular shape. As explained in the rejection above, Examiner's obviousness rationale is based on page 5 of Applicant's specification, which suggests that the angular shape of the rhombus markings allows the orientation of the packaging to be determined by a scanner. The markings of Niske are of a triangular shape, thereby also providing angles by which the orientation of the packaging can be determined. Particularly since the angles of the triangular markings are associated with the fold lines of the packaging, permitting a relationship between the markings and the fold lines to be established, thereby creating parameters to determine orientation of the packaging.

In light of the responses provided by Examiner, the rejection of Applicant's claimed invention is maintained.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GLORIA R. WEEKS whose telephone number is (571)272-4473. The examiner can normally be reached on M-F 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199

/Gloria R. Weeks/

Examiner, Art Unit 3721

/Rinaldi I Rada/

Supervisory Patent Examiner, Art Unit
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July 24, 2008